



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,097	06/15/2001	Valerie De La Poterie	05725.0905-00	7312
22852	7590	10/20/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/881,097	<b>Applicant(s)</b> DE LA POTERIE ET AL.	
	<b>Examiner</b> Marina Lamm	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005 and 03 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13, 15-19 and 21-59 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15-18, 21-56 and 59 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

225

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 7/11/05 and the supplemental amendment filed 8/3/05. Claims pending are 1-10, 12, 13, 15-19 and 21-59. Claim 20 has been cancelled. Claims 1, 12, 13 and 54-56 have been amended. Claims 57 and 58 remain withdrawn from consideration as directed to non-elected invention.

The Applicant has previously elected polycaprolactones as thermal transition agents and polyurethanes as film-forming polymers.

#### ***Allowable Subject Matter***

1. Claim 19 is objected to as being dependent upon a rejected base claim (see below), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of Claims 1-10, 12, 13, 15-18, 21-56 and 59 (*as applicable to the non-elected species*) under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is maintained for the reasons of the record.

#### ***Double Patenting***

4. The ODP rejection of Claims 1-10, 12, 13, 15-18, 21-56 and 59 as being unpatentable over claims 1-30, 32-37, 45 and 46 of copending Application No. 10/138,325, now US Patent 6,946,518, is maintained for the reasons of the record.

***Response to Arguments***

5. The rejection of Claims 12 and 13 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of the amendment to Claims 12 and 13, filed 7/11/05.
6. The rejection of Claims 1-10, 12, 13, 15-18, 20-25, 46, 47 and 52-56 under 35 U.S.C. 102(b) as being anticipated by Hayashi et al. (EP 367 015) has been withdrawn in view of the amendment to Claims 1 and 54-56, filed 8/3/05.
7. Applicant's arguments filed 7/11/05 with respect to the lack of written description rejection under 35 U.S.C. 112, first paragraph, have been fully considered but they are not persuasive.

The Applicant argues: "Notably, however, Federal Circuit case law establishes that a single species can provide adequate written description support for a larger genus **where the disclosure provides sufficient information and guidance that one skilled in the art would readily know the other members of the genus that could be used.** See e.g., *Utter v. Hiraga*, 845 F.2d 993 (Fed. Cir. 1988)." See p. 15 of the reply. (Emphasis added). This is not the case here. The instant specification **does not** provide sufficient information and guidance for one skilled in the art as to what members of the genus of semi-crystalline compounds having the specified transition temperature and water-solubility, other than polycaprolactones, could be used in the instant invention.

Further, the Applicant argues: "In this case, however, it is abundantly clear that the other members of the genus would perform similarly by the fact that the genus is e

Art Unit: 1616

functionally defined, i.e., by the transition temperature range and lack of water solubility below the transition temperature of the semi-crystalline compounds in the genus." See p. 16 of the reply. In response, it is not clear what are these "the other members of the genus" referred to by the Applicant. The Applicant is invited to name such compounds, so that the Examiner is able to fully search the entire scope of the claims.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

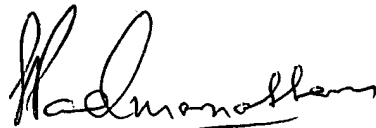
Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm  
10/17/05

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER